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EXAMINER				
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The time period for reply, if any, is set in the attached communication.

1 RECORD OF ORAL HEARING

2 UNITED STATES PATENT AND TRADEMARK OFFICE

3 \_\_\_\_\_  
4 BEFORE THE BOARD OF PATENT APPEALS  
5 AND INTERFERENCES

6 \_\_\_\_\_  
7 *Ex Parte* JOHN W. CHRISMAN III.

8 \_\_\_\_\_  
9 Appeal 2009-001028  
10 Application 09/832,141  
11 Technology Center 3700

12 \_\_\_\_\_  
13 Oral Hearing Held: May 21, 2009

14 Before DEMETRA J. MILLS, LORA M. GREEN and JEFFREY N.  
15 FREDMAN, *Administrative Patent Judges*.

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PROCEEDINGS

MS. BEAN: Good afternoon. Calendar No. 62. Mr. Burton.

JUDGE MILLS: Thank you.

MS. BEAN: You're welcome.

MR. BURTON: Good morning.

JUDGE MILLS: Feel free to get set up, and of course, you have --

MR. BURTON: Thank you very much.

JUDGE MILLS: -- 20 minutes, and you can begin whenever you're ready. And if you wouldn't mind --

MR. BURTON: Thank you.

JUDGE MILLS: -- providing the court reporter with a business card.

MR. BURTON: Certainly.

Your Honors, I'm -- I suppose I'm ready to go forward.

JUDGE MILLS: Okay, good.

MR. BURTON: First of all, thank you this afternoon. My name is Dickson Burton. My partner Brick Power has been primarily the prosecuting attorney on this, on this case, and I'm pleased to be here.

Your Honors, this is a case essentially where we would assert the Examiner has I suppose been stubborn in not, in not recognizing the, the unusually unexpected success of this invention that was, that was not predictable, that was not anticipated but is instead relying on references that do provide some of the building blocks for this invention undoubtedly but again would not lead one toward -- of ordinary skill in the art to the

1 conclusions or to anticipate I should say the, the success that has been  
2 experienced. KSR in fact states that the Supreme Court states that  
3 inventions usually rely upon building blocks long since uncovered, and  
4 claimed discoveries almost necessarily will be combinations of what in some  
5 sense is already known. The Court goes on to explain that the inquiry  
6 should be does it lead, do those pre-existing building blocks lead to  
7 anticipated, predictable success. And particularly with respect to the claims  
8 in our case that go to the bowling ball, we would submit that in fact those of  
9 ordinary skill in the art were led away from using these building blocks  
10 which is adding the fragrance to the resins in manufacturing the bowling  
11 ball.

12 JUDGE FREDMAN: What would you state is the level of skill in the  
13 art?

14 MR. BURTON: Your Honor, the Examiner seems to want to say that  
15 it's a bowler. We would respectfully disagree. We think it is a manufacturer  
16 of bowling balls. It's one who is -- has knowledge of putting the building  
17 blocks, as it were, together to make the bowling ball. It's not one that is just  
18 skilled at rolling the ball down the lane. Okay.

19 JUDGE MILLS: Do you have an issue with the Examiner's prima  
20 facie case, or are you relying solely on your unexpected results?

21 MR. BURTON: We do have an issue with the prima facie case as  
22 well, Your Honor, and the Examiner is relying on two references. The final  
23 rejection cites Shibantai, if I pronounce that correctly, and Coffey (phonetic  
24 sp.), neither of which discloses use of a fragrance with a two-part resin.

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1 Your Honor, those references I think are distinctly different from what we're  
2 talking about here. Shibantai talks about adding a fragrance into a  
3 cyclodextrin, the fragment of a starch. That compound is then dried, ground  
4 up and crushed into a powder. Then it is mixed with a resin, and that  
5 disclosure talks about thermoplastic or thermo-set resins. It's formed into  
6 pellets or further just used in the powder in a malt. Typically, all of the  
7 examples I believe talk about forming these pellets of this cyclodextrin  
8 compound with the resin. All of that seems to be concerned with dealing  
9 with the heat that is later applied in forming and curing the resins.

10 Coffey is similar and yet also quite different on its own. There we're  
11 talking about natural fragrances in botanical material. We're talking about  
12 bits of flowers or pods, and that natural botanical material is bound by what  
13 the patent disclosure describes as a minor amount of a fluorocarbon resin, a  
14 fluorocarbon resin binder such as Teflon, and then it is baked by heating it to  
15 the curing temperature of that resin. So again we're talking about a one-part  
16 resin process, thermoplastic in that case, and again quite different. Those  
17 references are simply not going to lead someone to the type of article of  
18 manufacture that is a bowling ball. It has a very different purpose that is  
19 used -- that is manufactured with a two-part resin process.

20 And here we have the bowling industry, and this is made reference to  
21 in Mr. Chrisman's, one of his declarations. I believe it's the March 29, '06  
22 declaration where he talks about how bowling manufacturers are extremely  
23 reluctant to add anything into their product that might impact performance.  
24 Now as we know these fragrances, and they're often oils, are going to

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1 eventually leach out to the surface. And so there would be great reluctance  
2 to add something like a fragrance to the, the bowling ball. And again,  
3 neither of the references that the Examiner relies upon tell us anything  
4 differently from that.

5 And so again I -- we do have the problem with the prima facie case.  
6 But getting past that prima facie case, the Examiner again did not want to  
7 accept the overwhelming commercial success. Now he has some criticisms  
8 in, in some of his rejections of the evidence that was put forward saying we  
9 don't know that -- what it's attributable to, and a great PR firm might have  
10 gotten all this media. But Mr. Chrisman responded again in his March '06  
11 declaration very plainly stating --

12 JUDGE MILLS: Could we back up just real --

13 MR. BURTON: Excuse me?

14 JUDGE MILLS: Could we back up just real quickly  
15 before we go into the commercial success evidence?

16 MR. BURTON: Certainly.

17 JUDGE MILLS: The Examiner seemed to have an issue regarding  
18 the prima facie case with the definition of your two-part resin and seem to  
19 believe that epoxy resins read on your definition and specification. Do  
20 you -- could you address that for a moment?

21 MR. BURTON: Certainly, Your Honor. The Shibanaï reference  
22 where it mentions the epoxy resin talks about, if I can get it in front of me,  
23 this is column 7, lines 54 to about 60 of that reference. It's talking about a  
24 synthetic resin coating first of all, and then it gives an example of synthetic  
25

1 resin coatings are alkaloid resin coatings and so forth and, and lists epoxy  
2 resin coatings.

3         So first of all, it's unclear when it's talking about a coating whether it's  
4 talking about even the, the substance into which the fragrance is added. I  
5 don't think that's clear from this reference at all. Secondly, there are  
6 different types of epoxies, and within this reference, it is, it is talking about  
7 the combination with the cyclodextrin and, and the creation of the glycitol  
8 which forms a covering over, over this -- these pellets to help the fragrance  
9 withstand the heat. So again, we're not talking about a two-part resin where  
10 there's simply a catalyst, and after the addition of the catalyst you get a cure  
11 without adding any other heat. And so again, a person of skill in the art  
12 looking at that reference is not going to see epoxy resins as the two-part  
13 resin that is contemplated in Mr. Chrisman's application.

14         JUDGE MILLS: Could you direct me to where in the specification it  
15 defines your two-part resins?

16         MR. BURTON: I'm sorry?

17         JUDGE MILLS: Can you direct me to where in the specification that  
18 you have defined your two-part resins?

19         MR. BURTON: Oh, okay, in our application.

20         JUDGE MILLS: Yeah.

21         MR. BURTON: Well, Your Honor, in -- we have not defined the  
22 term two-part resin, conceded. However, the, the first several pages --

23         JUDGE FREDMAN: Would you, would you concede that two-part  
24 resins were well known in bowling ball making?

25

1           MR. BURTON: Yes, we would concede that.

2           JUDGE FREDMAN: Okay. So I mean so it's more than I think the  
3 secondary considerations that should drive this it sounds like. I would like  
4 to have you discuss something that you put in your -- I guess it's a piece of  
5 evidence you added to the declaration, the article by Jonathan Eig in -- I  
6 can't tell where it's from here. It must have been a newspaper though,  
7 because you have some statements in it that I think are interesting where he  
8 says but to nearly everyone's surprise, including plenty of bowlers -- when  
9 they got their first whiff, Storm's scented balls are quite popular between the  
10 pro-shop owners and others in the business, and they have turned the little  
11 company into one of the hottest players in an otherwise down-at-the-heels  
12 industry. I wonder if you could discuss maybe more of this for secondary  
13 considerations with regard to some of these articles.

14          MR. BURTON: Certainly. Your Honor, it was a phenomenon that  
15 was not expected by Storm Products, which is the company owning the  
16 application, the, the publicity that kind of took on a life of its own. And as  
17 Mr. Chrisman states in his declaration, it was not solicited. They did not  
18 have a PR firm. They did not have an in-house PR person.

19          JUDGE FREDMAN: Where does he say that? I'm not --

20          MR. BURTON: That was in the March 29 declaration that was  
21 submitted --

22          JUDGE FREDMAN: March 29 of what year?

23          MR. BURTON: -- in connection with the original Appeal Brief, and  
24 paragraph 5, Your Honor.

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1 JUDGE FREDMAN: March 29 of what year?

2 MR. BURTON: '06, I'm sorry.

3 JUDGE FREDMAN: Well, keep going.

4 MR. BURTON: Okay.

5 JUDGE FREDMAN: I'll find it or not.

6 MR. BURTON: Okay, well, I'll read from it. It says "The positive  
7 press received by Storm in connection with its scented bowling ball  
8 indicating that which is referenced in my June 24, 2005 declaration," and  
9 that's the one I believe that enclosed not only articles but a DVD or a CD  
10 with video on it from the "Today" show and a number of other national and  
11 local television broadcasts.

12 JUDGE FREDMAN: Right.

13 MR. BURTON: He goes on to say "has not been solicited by Storm.  
14 Storm does not have a public relations expert or firm and did not retain one  
15 to generate any of the press which has been received by Storm for its scented  
16 bowling ball. Neither Storm nor any representative of Storm solicited the  
17 newspaper, television and other media reports and accounts including those  
18 referenced in my prior declaration."

19 He goes on to respond to the Examiner's concern that the increased  
20 sales are a result of advertising dollars, and he says that -- very clearly in  
21 paragraph 6 of that same declaration that the advertising increases that it was  
22 able to afford because of increased sales followed the upward trend in the  
23 sales. It -- he says while Storm has gradually increased its overall  
24 expenditures in marketing since 2001, which is a year after it introduced the  
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1 scented bowling ball, the increases have followed the surprising success of  
2 the scented bowling ball. They have not preceded that success. It is clear  
3 from our sales and marketing expenditures history that Storm has only been  
4 able to increase expenditures because it first had increased sales revenue  
5 from the scented bowling ball.

6 Now in his other declaration, he explained how bowling balls in the  
7 same market segment are lower priced than the scented bowling ball. It is a  
8 clear mark of success. It has allowed Storm to increase its market share  
9 dramatically, and that can only be attributed to the, to the fantastic success of  
10 this invention. It, it seems to be overwhelming evidence of commercial  
11 success.

12 Now recognizing again that the building blocks for this invention  
13 were in place, but again, as, as KSR talk about, the next question is do those  
14 building blocks lead to a predicted level of success, to anticipated success,  
15 and again, in the context of a bowling ball and talking particularly about the  
16 bowling ball claims that we have in our claims set, it was absolutely not  
17 expected, and in fact, the opposite would have been expected.

18 And so Your Honors, it's a simple case. Right now I don't have  
19 anything else to argue. If there are other questions, I'll address them, but  
20 that is our presentation, and we would urge your consideration of our  
21 position.

22 JUDGE MILLS: Okay, I don't have any further questions. No, okay.

23 MR. BURTON: Thank you very much.

24 JUDGE MILLS: Okay, thank you.

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1 JUDGE FREDMAN: Thank you.  
2 (Whereupon, the hearing concluded at 1:29 p.m., on May 21, 2009.)  
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